

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No.: 10/521,652
Filing Date: January 14, 2005
Appellant: Jonathon Reo Campian
Group Art Unit: 1791
Confirmation No.: 2215
Examiner: James D. Sells
Title: APPARATUS AND METHOD FOR HOLDING
MATERIALS FOR THE FORMING AND JOINING
THEREOF
Attorney Docket: 5772-000004/US/NP

Mail Stop Reply Brief - Patents
Director of the U.S. Patent and Trademark Office
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REPLY BRIEF ON BEHALF OF APPELLANT

I. INTRODUCTION

The present Reply Brief is being submitted in the above-identified appeal in response to the Examiner's Answer mailed April 27, 2010.

II. WITHDRAWN REJECTIONS

Appellant acknowledges and appreciates the Examiner's reconsideration and withdrawal of the rejections of claims 2-12, 22-27, 32, 34-35 and 49-51 under 35 U.S.C.

§ 112, first paragraph. Accordingly, these claims are believed to be in condition for allowance.

III. **ARGUMENT**

The remaining issue on appeal is whether the method recited in claims 47-48 and 52 is patentable over the combined teachings of U.S. Patent No. 5,228,190 to Sawa ("Sawa") in view of U.S. Patent No. 5,375,951 to Veale ("Veale"). Appellant submits that an error has been made in: (A) the factual determination that Veale describes a sealed elongated channel and the method of immobilizing a metal panel as recited in Claim 52; and (B) the reasoning used to support the combined teachings of the prior art. These errors led to the incorrect conclusion that the claimed subject matter was obvious. See, *In re Frye*, 94 USPQ2d 1072, 1075 (Bd. Pat. App. & Int. 2010).

(A) The Prior Art Fails To Describe The Claimed Subject Matter

Claim 52 is directed to a method for forming a body panel by joining of a first metal panel to a second metal panel. In part, the claimed method includes:

"locating a first metal panel on an upper surface of a lower nest such that a perimeter region on a first side of said first metal panel is supported on a generally flat material-contacting area of said frame and **an interior region of said first side engages a pad such that a sealed elongated channel is formed between said pad and said first metal panel adjacent a portion of said material-contacting area;**

evacuating said sealed elongated channel to immobilize said first metal panel on said frame....

The claimed subject matter recites a particular method and associated structure forming a sealed elongated channel between a pad and the first metal panel which is evacuated to immobilize the first metal panel.

The Examiner acknowledges that Sawa does not describe this subject matter, instead relying on the teachings of Veale. See Ex. Ans., p. 4-5. In particular the Examiner states that:

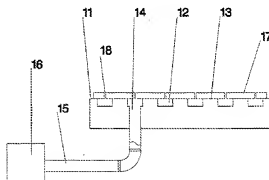
"Sawa does not disclose the interior region having an elongated channel and evacuating the elongated channel to immobilize the first metal panel in the manner claimed by the applicant."

Id. at p. 4.

"Elements 12 of Veale are described as channels and are shown with elongated portions. See col. 3, lines 27-36 and Figs. 3-4 of Veale. Material 17 is placed on top of bed 11 sufficient to cover channels. See col. 4, lines 20-22. This creates the sealed elongated channels in the manner recited in applicant's claims."

Id. at p. 5.

This finding ignores the fact that holes 18 are drilled through material 17 corresponding to the channels 12. See Veale, col. 4, lines 20-24 and Fig 4B (reproduced right). As a result, the channels 12 are not sealed by material 17 and cannot form a



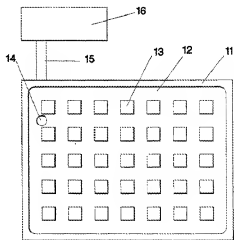
sealed elongated channel. Appellant submits that an unreasonably broad construction of what is "a sealed elongated channel" has been adopted in reaching this erroneous finding. In addition to the explicit claim language emphasized above, Appellant directs the Board to the following portion of the specification when considering what constitutes "a sealed elongated channel":

Each vacuum pad 208 has a dual purpose – first, to provide a substantially air-tight seal with respect to the first sheet material A and, second, to provide a cushioned surface support for carefully supporting the first sheet material A while preventing its deformation. Accordingly, it is preferred that the vacuum pads 208 be composed of an elastic or semi-elastic polymerized material suitable for these purposes.

Specification, p. 9 at ¶[0037] (emphasis added).

Therefore, Appellant submits that the factual finding that “Veale creates the sealed elongated channels in the manner recited in applicant’s claims” is in error. See Ex. Ans., p. 5.

The Examiner also disputes Appellant’s contention that “Veale does not disclose ‘an interior region of said first side engag[ing] a pad such that a sealed elongated channels is formed between said pad and said first metal panel adjacent a portion of said material-contacting area...’” See Ex. Ans., p. 6. The Examiner explains that the interconnected



channels 12 have elongated portions that are covered by material 17. See Ex. Ans., p. 5 citing Veale, col. 3, lines 27-36; col. 4, lines 20-22; and FIG 3-4 (reproduced right and above, respectively). The Examiner fails to provide any factual support that Veale describes the claimed relationship of the pad and the sealed elongated channel relative to the interior region and the material contacting portion of the lower nest.

In pertinent part, claim 53 recites “an interior region of said first side [of said metal panel] engages a pad such that a sealed elongated channel is formed between said pad and said first metal panel adjacent a portion of said material-contacting area...” (emphasis added). The mere conclusory statement that Veale

discloses the claimed subject matter does not refute the facts raised by Appellant above (and in its Appeal Brief, pp. 21-23). In view of the admission concerning the deficiencies in the teachings of Sawa, and the erroneous factual findings of Veale, evidence sufficient to make a *prima facie* case of obviousness has not been presented, and the rejection on obviousness grounds should not be sustained. See *In re Frye*, 94 USPQ2d at 1075-76.

(B) No Apparent Reason To Combine The Prior Art Was Articulated

Substantial evidence showing an apparent reason to combine the teachings of Sawa and Veale to arrive at the subject matter recited in Claims 47-48 and 52 has not been established. See, *Ex parte Whalen*, 89 USPQ2d 1078, 1084 (Bd. Pat. App. & Int. 2008)(rejection premised on the obviousness of modifying the prior art is not established merely by stating that the claimed subject matter is the result of routine experimentation or solely on the expectation of success) citing *KSR Int'l Co. v. Teleflex Inc.*, 550 US 398 (2007).¹

The Examiner maintains that "it would have been obvious to one having ordinary skill in the art to employ a vacuum channel system, as taught by Veale, in the method of Sawa in order to provide the predictable result of more accurately and precisely aligning and holding the workpieces during automated processing." Ex. Ans., p. 4. See also, Final Office Action dated 5/11/2009, p. 4. There are no factual findings to support this conclusion! No finding that one of ordinary skill in art would have substituted the bed of Veale for the fixtures of Sawa, or that the proposed substitution would be operable for

¹ "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l*, 550 US at 418 citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

its intended purpose. No finding that one of ordinary skill in the art recognized a problem with aligning and holding a workpiece, or that the proposed modification would more accurately and precisely align and hold workpieces during automated processing. When such factual findings are not articulated, the necessary underpinning to establish obviousness is missing. See, Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, Fed. Reg. Vol. 72, No. 195, 57526, 57527 (Oct. 10, 2007).

In rebuttal to this conclusory statement, Appellant notes that Veale describes "a method for making a bed for an automated milling machine which is less expensive and more practical than other automated milling machine beds currently on the market." Veale takes no position on the accuracy and precision of aligning and holding the workpieces during milling. See, e.g., Veale, col. 1, lines 62-65. Sawa is void of any details concerning the manner of aligning or holding the workpieces. See e.g., Sawa, col. 3, lines 41-50. In further support its position, Appellant has explained that the modification proposed by the Examiner would be inoperable for purposes of the claimed subject matter, and therefore does not provide a rational to support the rejection under 35 U.S.C. §103. See, Specification, p. 9, ¶[0037]; Appeal Brief, pp. 23-25 (inoperability of proposed modification explained). Simply put, there is no evidence establishing that one of ordinary skill in the art would have an apparent reason to modify Veale and/or Sawa in a way to arrive at the claimed subject matter. See, *Ex parte Whalen*, 89 USPQ2d at 1084 (it must be shown that those of ordinary skill in the art would have had some apparent reason to modify the prior art in a way that would result in the claimed subject matter).

When objectively reviewed, the Examiner's obviousness analysis consists of an identification of select components or features from each of the cited references and then a conclusory statement of obviousness with insufficient factual findings. Without an articulated reasoning with rationale underpinnings to support the conclusion of obviousness, the final rejection is improper and must be set aside.

IV. CONCLUSION

For the reasons discussed herein and in its opening Appeal Brief, Appellant respectfully submits that the Examiner erred in his factual findings concerning the scope and content of the prior art and its differences as compared with the claimed subject matter, and lacks proper factual foundation for the modification of the prior art proposed to arrive at the claimed subject matter. The foregoing errors resulted in an improper conclusion of obviousness. Claims 47-48 and 52 are not rendered obvious by Sawa in view of Veale, and the Final Rejection dated May 11, 2009 should be overturned.

Respectfully submitted,

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